

REMARKS

Applicant has carefully studied the outstanding Official Action. The present amendment is intended to be fully responsive to all points of rejection and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the present application are hereby respectfully requested.

Applicant thanks the Examiner for the courtesy of an interview granted to Applicant's representative, David Zviel, registration number 41,392, on 14 June 2004. Applicant also thanks Examiner Christopher Revak, who was also present at the interview.

In the interview, claims 1, 4, 6, 10, 29, and 30 were discussed in light of Linnartz and Bloom et al.

In the interview, Applicant's representative pointed out, as discussed in more detail below, that Linnartz describes use of a strong watermark "barrier" which is difficult to break; in contrast, the present application describes the drawbacks in approaches, such as that of Linnartz, which rely on making the illicit removal of watermarks difficult. Certain embodiments of the present invention, including the embodiment as claimed in the claims discussed in the interview, provide protection after a watermark is successfully and illicitly removed.

Furthermore, as discussed in more detail below, Applicant's representative pointed out that there are elements claimed in the claims discussed in the interview which are nowhere shown or suggested in Linnartz or in Linnartz in combination with Bloom et al.

Applicant's representative also pointed out that claims 29 and 30, which depend from claims 1 and 10 respectively, make particularly clear the distinction of claims 1 and 10 over the prior art, although Applicant takes the position that claims 1 and 10 are themselves clearly distinguished over the prior art.

Claims 1 - 30 are pending in the present application before the present amendment. Claims 17 - 26, 29, and 30 are cancelled without prejudice by

the present amendment. New claims 31 - 46 are added by the present amendment. Thus, claims 1 - 16, 27, 28, and 31 - 46 are now pending in the present application.

Claims 10 - 12 and 14 stand rejected under 35 USC 102(e) as being anticipated by US Patent 6,314,518 to Linnartz.

Linnartz describes a system for copy protecting content information in which playback of received video is controlled. Playback is allowed depending on a watermark, which is extracted in a separate decoder device.

In the present invention, as claimed in claim 10, a watermark examiner includes “a watermark definition signal receiver operative to receive a signal indicating that a new watermark definition is to be used for examining electronic representations and to store the new watermark definition in the watermark definition store.”

The Examiner takes the position that the portion of the recitation of claim 10 cited above is described in Linnartz at col. 1, lines 5 - 16; col. 2, lines 1 - 19; and col. 3, lines 58 - 65.

Applicant has carefully studied Linnartz, including the passages cited by the Examiner, and finds that Linnartz does not describe receiving “a signal indicating that a new watermark definition is to be used”, as recited in claim 10. In fact, Linnartz teaches that a strong “barrier” that pirates are unable to break at reasonable cost should be used, and that upgrading control measures is disadvantageous (col. 3, lines 47 - 57); thus, Linnartz teaches away from using a new watermark definition, as recited in claim 10.

Furthermore, the present application describes the drawbacks in approaches, such as that of Linnartz, which rely on making the illicit removal of watermarks difficult. Certain embodiments of the present invention, including the embodiment as claimed in claim 10, provide protection after a watermark is successfully and illicitly removed. The drawbacks of the prior art and the protection provided by certain embodiments of the present invention are described, inter alia, on page 5 of the specification. Thus, the present invention as claimed, inter alia, in claim 10 solves a problem very different from that addressed by Linnartz.

The Examiner, on pages 2 and 3 of the present Office Action, states that:

The actual signal that is received is not defined to perform any function but inform the reader that there is a watermark to be examined in the electronic representation....Linnartz discloses that the system provides “detection of the watermark, and communicates the result back to the receiving device.” This communication is a signal that provides the receiving device knowledge of a new watermark.

Applicant respectfully points out that the Examiner’s reading of claim 10 and of Linnartz are incorrect. Reading claim 10 as a whole, it is clear that, once a new watermark definition is stored in the watermark definition store, the apparatus of claim 10 checks for watermarks in accordance with the new watermark definition, since it is explicitly recited that the apparatus comprises “watermark examination apparatus operatively associated with the watermark definition store and operative to examine an electronic representation of an item for a watermark in accordance with the watermark definition stored in the watermark definition store” (emphasis added). The system of Linnartz, even as described by the Examiner, nowhere suggests such a feature. As the Examiner himself points out, the system of Linnartz communicates a result of detecting a watermark; the system of Linnartz does not receive a watermark definition and examine for a watermark in accordance with that definition.

Claim 10 is therefore deemed allowable.

Claims 11, 12, and 14 depend from claim 10 and recite additional patentable subject matter and are therefore deemed allowable.

Claims 1 - 9, 13, and 15 - 28 stand rejected under 35 USC 103 as being unpatentable over Linnartz in view of US Patent 6,332,194 to Bloom et al. It appears that the Examiner also intended to include claims 29 and 30 in the 35 USC 103 rejection over Linnartz in view of Bloom et al, since the Examiner included claims 29 and 30 in the discussion of the 35 USC 103 rejection.

Bloom et al describes a method for data preparation and watermark insertion; in at least one preferred embodiment described by Bloom et al, two watermarks are used.

Claim 1 recites “examining at least a first electronic representation of an item for a watermark in accordance with a first watermark definition; receiving a signal indicating that a second watermark definition is to be used for examining electronic representations; and examining at least a second electronic representation of an item for a watermark in accordance with the second watermark definition.” (emphasis added)

The Examiner correctly points out that Linnartz does not explicitly describe the emphasized portion of claim 1 cited above. The Examiner takes the position, on pages 7 and 8 of the outstanding Office Action, that the system of Linnartz “can communicate supplemental watermark information and therefore should be able to provide information to the decoder device whether or not to consider the second watermark outlined by Bloom. The detector device outlined by Linnartz could then examine the second watermark instead of the first watermark. This would provide a more robust system of watermarking which is more resistant to tampering.”

Applicant has carefully studied Linnartz and Bloom et al. Applicant respectfully points out the that Examiner’s position concerning the combination of Linnartz and Bloom et al is incorrect for at least the following reasons:

1. Linnartz nowhere teaches or suggests the existence or use of information concerning using a second watermark definition. The Examiner’s position is therefore purely speculative and not based on the teachings of the reference.

2. As pointed out above in the discussion of the 35 USC 102 rejection of claims 10 - 12 and 14 over Linnartz, Linnartz explicitly teaches away from using a second watermark definition, and from the concept that such a system would be more robust, by teaching that a strong “barrier” that pirates are unable to break at reasonable cost should be used, and that upgrading control measures is disadvantageous (col. 3, lines 47 - 57). Thus, the Examiner’s combination of Linnartz with Bloom et al is improper.

3. Even if it were proper, contrary to the position of Applicant, to combine Linnartz with Bloom et al, the result would be a system that could check two watermarks; such a system would still lack the feature of “receiving a signal indicating that a second watermark definition is to be used for examining electronic representations” as recited in claim 1, since neither Linnartz nor Bloom et al describes or suggests such a feature.

It is respectfully pointed out that the Examiner, in responding to Applicant’s previous arguments on pages 2 - 4 of the present Office Action, does not directly address points 2 and 3 above, which were also presented previously in response to the previous Office Action. The Examiner’s statement that “the combination of Linnartz and Bloom seems logical” does not overcome Applicant’s arguments regarding the impropriety of the combination and the fact that the combination would still lack a feature recited in claim 1.

Furthermore, while the Examiner states that “the combination of Linnartz and Bloom seems logical”, Applicant respectfully points out that it is not clear from the Examiner’s rejection what motivation is alleged to exist for combining the two references. Conclusory statements are insufficient, and it is necessary to articulate the rationale for choosing particular combinations of prior art. *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Id.* at 1343, 61 USPQ2d at 1433. The examiner can satisfy the burden of showing obviousness of a combination only by showing objective teaching in the prior art or other objective evidence that one of ordinary skill in the art would combine the relevant teachings of the references. *Id.* at 1343, 61 USPQ2d at 1434. The mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious absent some objective teaching, suggestion or incentive supporting the proposed combination. *Ex parte Metcalf*, 67 USPQ2d 1633, 1635 (Bd.Pat.App. 2003).

Applicant therefore respectfully points out that the rejection of claim 1 is improper because the Examiner has failed to make a *prima facie* case of unpatentability; the rejection should therefore be withdrawn.

Claim 1 is therefore deemed allowable.

Claims 2 - 9 depend from claim 1 and recite additional patent subject matter and are therefore deemed allowable.

Claim 13, 15, and 16 depend from claim 10, deemed allowable as discussed above, and recite additional patentable subject matter. Claims 13, 15, and 16 are therefore deemed allowable.

In order to facilitate allowance of the present application or, if necessary, to place the present application in better condition for appeal, claims 17 - 26 have been cancelled without prejudice. Applicant reserves the right to pursue claims 17 - 26 in the context of a continuing application.

Claim 27 includes recitation similar to that discussed above with reference to claim 1. The arguments advanced above concerning the allowability of claim 1 apply also to claim 27.

Claim 27 is therefore deemed allowable.

Claim 28 depends from claim 27 and recites additional patentable subject matter and is therefore deemed allowable.

Claims 29 and 30 explicitly recite that, once a new watermark definition is received, examining takes place in accordance with the new watermark definition and not in accordance with any previous watermark definition. As mentioned above, claims 29 and 30, which were added in the response to the previous Office Action, make particularly clear the distinction of claims 1 and 10 over the prior art, although Applicant takes the position that claims 1 and 10 are themselves clearly distinguished over the prior art.

In rejecting claims 29 and 30, the Examiner takes the position that the features recited in claims 29 and 30 "would have been obvious", without citing any prior art describing such features. The rejection of claims 29 and 30 is therefore clearly improper, since no *prima facie* case of unpatentability against claims 29 and 30 has been made by the Examiner. The rejection of claims 29 and 30 should therefore be withdrawn.

Furthermore, claims 29 and 30 depend, respectively, from claims 1 and 10 and recite additional patentable subject matter.

Claims 29 and 30 are therefore deemed allowable.

However, as explained below, claims 29 and 30 have been cancelled and replaced with corresponding claims re-written in independent form.

New claims 31 - 46 have been added.

Claim 31 corresponds to previous claim 29, which depended from claim 1, rewritten in independent form.

Claims 31 - 39 depend from claim 31 and correspond to claims 1 - 9, respectively.

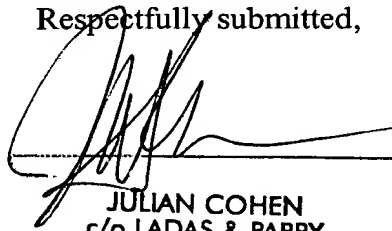
Claim 40 corresponds to previous claim 30, which depended from claim 10, rewritten in independent form.

Claims 41 - 46 depend from claim 40 and correspond to claims 11 - 16, respectively.

As discussed above, Applicant takes the position that claims 1 and 10 are allowable without amendment. Nevertheless, claims 31 and 40 and their respective dependent claims have been added, *inter alia*, to place the present application in better condition for appeal should the Examiner maintain the rejection of the claims.

In view of the foregoing remarks, it is respectfully submitted that the present application is now in condition for allowance. Favorable reconsideration and allowance of the present application are respectfully requested.

Respectfully submitted,



JULIAN COHEN
c/o LADAS & PARRY
26 WEST 61st STREET
NEW YORK, N. Y. 10023
Reg. No. 20302 (212) 708-1887